

## REMARKS

Claims 1, 2, 7-13, 16-20 are pending. Claims 3-4, 6, 14-15 have been canceled. No claims have been withdrawn.

**Claims 1,2,6-8,10,12-13,17 and 20 stand rejected under 35 USC 103 as being unpatentable over US Patent Publication No. 2003/0220691 (“Songer”) in view of US Patent No. 5,071,437 (“Steffee”).**

In formulating this rejection, the Examiner noted that Songer does not disclose a porous coating on the vertebral endplates, but cited Steffee as teaching the use of a porous coating covering the surface of a motion disc in order to promote tissue ingrowth into the plates and attachment of the vertebrae to the disc, and concluded that it would have been obvious to construct the Songer device with a porous coating on the endplates, in view of Steffee, in order to promote tissue ingrowth into the plates and attachment of the vertebrae to the disc.

Applicants respectfully traverse. In short, Songer desires relative sliding rotation of the vertebrae and so teaches that its endplates are not fixed to the respective vertebrae, and so therefore teaches away from providing a porous coating on the vertebral endplates.

In presenting the embodiment of device 175 of FIG. 11A-D, Songer teaches that its endplates are not fixed to the respective vertebrae because Songer desires relative sliding rotation of the vertebrae:

[0060] Accordingly, the surfaces 182 and 184 include radially extending bearing surface portions 182a and 184a that extend radially along the respective facing vertebral surfaces and central, axially extending bearing surface portions 182b and 184b that serve to locate the device 175 while also allowing relative sliding rotation of the vertebrae 20 and 22 thereabout and specifically 3600 about device axis 186 since the plate members 176 and 178 are not fixed to the respective vertebrae 20 and 22.

Songer also teaches that the embodiment of device 175 of FIG. 11A-d is substantially similar to that of device 175' of FIGS. 11E-H:

[0062] FIGS. 11E-11H are views of another device 175' similarly constructed to device 175 including upper and lower plates 176 and 178 with a ball bearing 180 therebetween.

Therefore, it is reasonable to conclude that, as with device 175, the plate members 176 and 178 in device 175' are not fixed to the respective vertebrae 20 and 22, and that they are not fixed because Songer did not want them to be fixed because Songer desired relative sliding rotation of the vertebrae. In contrast, the present invention requires porous coatings on its endplates for the purpose of promoting bony ingrowth therethrough so as to provide endplates that become fixed to their respective vertebrae.

It is well known patent law that two references can not be combined when one of the references would discourage such a combination. Where a reference warns against rather than teaches the invention, one can not expect to combine it with another teaching. In re Fine 5 USPQ 2d 1596 (Fed. Cir. 1988). A reference which leads the skilled artisan away from the claimed invention can not render it unpatentably obvious. Dow Chemical Co. v. American Cyanamid Co. 2 USPQ2d 1350 (Fed. Cir. 1987); In re Grasseli 218 USPQ 269 (Fed. Cir. 1983). There is no suggestion to combine if a reference teaches away from its combination with another source. Tec Air, Inc. v. Denso Manufacturing Michigan Inc. 52 USPQ 1294 (Fed. Cir. 1999).

Since Songer requires relative sliding rotation of the vertebrae, Songer teaches away from and discourages the use of porous coatings to attach the endplates to the vertebrae. Therefore, the cited references can not be combined and the present rejection should be withdrawn.

#### **Claims 9, 11 and 16 stand rejected as being unpatentable over Songer**

Since these claims depend from claim 1, and the "porous coatings" limitation is not disclosed, taught or suggested by Songer, and is indeed discouraged by Songer, this rejection should be withdrawn.

**Claims 18 and 19 stand rejected as being unpatentable over Songer in view of Steffee and US Patent No. 6,749,635 ("Bryan")**

Since these claims depend from claim 1, the "porous coatings" limitation is not disclosed, taught or suggested by Songer, and Songer teaches away from such a modification, this rejection should be withdrawn.

In addition, please provide any additional extensions of time which may be necessary and charge any fees which may be due to Deposit Account No. 10-0750, but do not include any payment of issue fees.

Should there be any remaining or further questions, the Examiner is requested to place contact the undersigned directly.

Respectfully submitted,

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